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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,570	09/14/2005	Aloys Wobben	970054.480USPC	5519

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SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

EXAMINER	
WHITE, DWAYNE J	

ART UNIT	PAPER NUMBER
3745	

MAIL DATE	DELIVERY MODE
10/13/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/516,570	WOBBEN, ALOYS	
	Examiner	Art Unit	
	DWAYNE J. WHITE	3745	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 July 2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,4,6-8,11 and 15-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,4,6-8,11 and 15-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 July 2010* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

Applicant's arguments filed 30 July 2010 have been fully considered but they are not persuasive. Claims 1, 3, 4, 6-81 11 and 15-20 are pending. Applicant has first argued that the Examiner has not provided any citations teaching a winch separate from a support structure. The Examiner points out however that Applicant has only made the limitation of not using a crane separate from the pylon. This limitation does not restrict anything other than a crane. Having a boom is not included in that negative limitation and thus is not read into the claim. Furthermore, if Applicant intends to claim that the winch has no support structure then Applicant needs to claim as such and further provide in the specification and the drawings how a winch (mounted on a vehicle that supports said winch) can operate without some sort of support to keep it in place.

Applicant further argues that the Examiner has taken the "vehicle" limitation out of context stating that the vehicle must be at the base of the wind power installation and have a winch mount thereon, and also a hauling cable passing from the winch to a cable passage means. Setting aside the fact that the cable and winch are clearly disclosed in all of the prior art references and the primary references in all the rejections have passages for the hauling cable, the Examiner question where Applicant is suggesting the vehicle is when in use. The wench references all recite ground vehicles so it is unclear how said vehicles are not at the base of the installation.

The Examiner again respectfully disagrees with Applicant's assertion of completeness of the inventions disclosed in the prior art. The Examiner points out the completeness of the inventions disclosed in the prior art has no bearing on rejections made in the previous Office

Action. Particularly, the prior art in a 103(a) situation provides teaches showing the state of the art at the time the invention was made. In the instant application, Boyer clearly shows that providing a winch on a vehicle is already known in the lifting art and the Examiner is combining the known winch with a known use. This is the essence of obviousness and thus a proper 103(a) rejection. Applicant cites MPEP 2141.02 (VI) to support that the prior art are must be considered in its entirety and thus each reference must be considered as a complete system. The Examiner points out however that MPEP 2141.02 (VI) also states,

"the prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed...." In re Fulton, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004).

Furthermore MPEP 2123 states:

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968)).

A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also > Upsher-Smith Labs. v. Pamlab, LLC, 412 F.3d 1319, 1323, 75 USPQ2d 1213, 1215 (Fed. Cir. 2005)(reference disclosing optional inclusion of a particular component teaches

compositions that both do and do not contain that component);< Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed.").

While Weitkamp and Boyer may teach complete systems they also show the state of the art and thus relevant to the claimed invention. Furthermore, Boyer clearly reasonably suggests to one of ordinary skill in the art that a winch can be attached to a vehicle. Applicant appears to be making the argument that Applicant has discovered attaching a wench to a vehicle which is clearly not the case. Further, it is clearly not the case that using a wench on a wind turbine installation is new and novel in the art. Applicant is essentially attempting to patent a system and method that has been repeatedly shown to be obvious to one of ordinary skill in the art and is fundamentally swapping a crane with a winch to perform the assembly of the wind turbine installation. Applicant only substantive argument is that the prior art showing all of the claimed subject matter can not be combined because they are complete systems and thus there is no motivation to combine. As clearly refuted above, this line of reasoning is flawed and does not comport with the current understanding of 35 USC 103(a) as motivation as been clearly provided by the Examiner without the use of Applicant's disclosure.

In regards to the passage of Applicant's disclosure cited by the Examiner, it is noted that the Examiner states that Applicant admits that is it is well known in the art to transport a winch to installation for raising and lowering components. Unless the Examiner is missing something, the winch must be transport only with the other components of the wind turbine assembly to the

site by a vehicle. This passage lends support to the Examiner's assertion that the prior art lifting systems cited herein are known to one of ordinary skill in the art as the winch cannot get to the installation site any other way.

In regards to prior art Jackson, Applicant argues that Jackson would be incapable of lifting components of a wind turbine; however this is not the essences of the rejection made. Jackson clearly teaches that a winch can be transported on a vehicle, whether or not the vehicle can with stand the forces irrelevant since Applicant has not made any specific requirements for the vehicle other than it being a transport vehicle. Therefore, the Examiner has maintained all of the previously indicated rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitkamp (EP-1101934 A) in view of Boyer (6,494,437). Weitkamp discloses a wind power installation ("installation") 10 comprising a pylon 14 having a pod 18; a winch 60; a base 12; at least one deflection roller 64 and at least one rope passage 50 in the region of the pylon head for passing through a hauling cable from the winch. Weitkamp further discloses a second cable passage means (See passage for cable 62) disposed above the pylon head and configured to raise and lower components of the installation within the pylon. The Examiner notes that the winch is

also located within the pylon and the pylon is a hollow shaft. Weitkamp does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Boyer teaches a winch being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Boyer for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Weitkamp and Boyer as disclosed above would be inherently capable of performing the method as claimed.

Claims 1, 3, 4, 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weitkamp (EP-1101934 A) in view of Jackson (3,829,064). Weitkamp discloses a wind power installation ("installation") 10 comprising a pylon 14 having a pod 18; a winch 60; a base 12; at least one deflection roller 64 and at least one rope passage 50 in the region of the pylon head for passing through a hauling cable from the winch. Weitkamp further discloses a second cable passage means (See passage for cable 62) disposed above the pylon head and configured to raise and lower components of the installation within the pylon. The Examiner notes that the winch is also located within the pylon and the pylon is a hollow shaft. Weitkamp does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Jackson teaches a winch system being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the

position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Jackson for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Weitkamp and Jackson as disclosed above would be inherently capable of performing the method as claimed.

Claims 8, 11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickelsen (EP 1101936 A2) in view of Boyer (6,494,437). Nickelsen discloses a wind power installation comprising: a pylon (not labeled); a base; a pod (referred to as the nacelle); a winch 31; a cable guide 35; a blade opening 33; and a cable 32 coupled to the winch wherein the winch may be located within the rear of the housing. Nickelsen further shows in Figure 7 shows the cable 32 passes through the opening 34 in the pod and a second opening in the pod (the second opening being the opening in the hub 2 for the blade which also acts as a second cable guide). Nickelsen does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Boyer teaches a winch being mounted on a transport vehicle. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Boyer for the purpose of installing components of a wind power installation. In regards to method claims 6 and 7 the combination of Nickelsen and Boyer as disclosed above would be inherently capable of performing the method as claimed.

In regards to claim 16, the Examiner notes that the host vehicle for the winch is not a crane.

With respect to claim 20, since the winch of Boyer is used to lift heavy components with out the use of a crane (as the vehicle is not a crane), and winch is inherently capable of lifting and lowering heavy components, it is clear that the combination of Nickelsen and Boyer meets all of the structural limitations as set forth herein.

Claims 8, 9, 11 and 15-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nickelsen (EP 1101936 A2) in view of Jackson (3,829,064). Nickelsen discloses a wind power installation comprising: a pylon (not labeled); a base; a pod (referred to as the nacelle); a winch 31; a cable guide 35; a blade opening 33; and a cable 32 coupled to the winch wherein the winch may be located within the rear of the housing. Nickelsen further shows in Figure 7 shows the cable 32 passes through the opening 34 in the pod and a second opening in the pod (the second opening being the opening in the hub 2 for the blade which also acts as second cable guide). Nickelsen does not disclose the winch being located outside the pylon mounted on a transport vehicle.

Jackson teaches a winch system being mounted on a transport vehicle that is not a crane. The Examiner also notes that Applicant states in the Background of the Invention that it is well known in the art to transport a winch to installation for raising and lowering components. Therefore, it is the position of the Examiner that it would have been obvious at the time the invention was made to one of ordinary skill in the art to provide the winch on a transport vehicle as taught by Jackson for the purpose of installing components of a wind power installation. In

regards to method claims 6 and 7 the combination of Nickelsen and Jackson as disclosed above would be inherently capable of performing the method as claimed.

CONCLUSION

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DWAYNE J. WHITE whose telephone number is (571)272-4825. The examiner can normally be reached on 7:00 am to 3:30 pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Look can be reached on (571) 272-4820. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dwayne J White/
Examiner, Art Unit 3745

DJW

/Edward K. Look/
Supervisory Patent Examiner, Art Unit 3745